

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

DECKERS OUTDOOR CORPORATION,
Plaintiff,
v.
LAST BRAND, INC.,
Defendant.

Case No. 23-cv-04850-AMO

**ORDER RE MOTIONS FOR
SUMMARY JUDGMENT**

Re: Dkt. Nos. 124, 142

Before the Court is Plaintiff Deckers Outdoor Corporation's ("Deckers") motion for summary judgment, Dkt. No. 124, and Defendant Last Brand, Inc. d/b/a Quince's ("Quince") motion for partial summary judgment, Dkt. No. 142. The motions are fully briefed and were heard before this Court on September 4, 2025. Having carefully considered the arguments made in the parties' papers and at the hearing, as well as the relevant legal authority, the Court hereby **GRANTS IN PART AND DENIES IN PART** Quince's motion and **DENIES** Deckers's motion for the following reasons.

I. BACKGROUND

Deckers designs and markets footwear products under various brands, including UGG. Quince is engaged in the retail of apparel and offered for sale through its website three products relevant here (the "Accused Products"), which Deckers contends infringe on three of its unregistered trade dresses ("Trade Dresses") and one of its patents. First, Deckers argues the Australian Shearling Mini Boot Accused Product infringes Deckers's Classic Ultra Mini Trade Dress, as well as its U.S. Patent No. D927,161 (" '161 Patent"). Second, Deckers argues the Australian Shearling Button Boot Accused Product infringes its Bailey Button Boot Trade Dress. Third, Deckers argues the Australian Shearling Clog Slipper infringes its Tasman Trade Dress.

Deckers initiated this action by filing a complaint in the Central District of California on June 12, 2023. Dkt. No. 1. The parties stipulated to transfer the case to this District, and the case was transferred here on September 19, 2023. Dkt. No. 19. On October 12, 2023, Deckers moved to dismiss. Dkt. No. 23. On November 2, 2023, Quince filed a first amended complaint, Dkt. No. 25, which Quince answered on November 16, 2023, Dkt. No. 26. On January 25, 2024, the parties stipulated to Deckers filing a second amended complaint (“SAC”). Dkt. No. 34-1. The SAC asserts the following claims for relief: infringement under the Lanham Act of Deckers’s Trade Dresses (Counts 1-3); infringement of its trade dresses under California common law (Count 4); unfair competition (Counts 5-6); and patent infringement (Count 7). *Id.*

Quince answered on February 8, 2024, and then filed an amended answer on February 28, 2024, Dkt. No. 40, which asserts 14 affirmative defenses. Deckers’s motion for summary judgment, Dkt. No. 124, and Quince’s partial motion for summary judgment, Dkt. No. 142, were filed on March 10, 2024. Each party also filed *Daubert* motions, which the Court has resolved by separate order. Additionally, the Court resolved Deckers’s motion to strike new work (Dkt. No. 131) and its evidentiary objections (Dkt. No. 184-1) at the September 4, 2025 hearing.

II. DISCUSSION

Deckers moves for summary judgment and Quince moves for partial summary judgment. The Court sets forth the relevant legal standard before considering Deckers’s motion and then Quince’s.

A. Legal Standard

Federal Rule of Civil Procedure 56 provides that a party may move for summary judgment on a “claim or defense.” Fed. R. Civ. P. 56(a). Summary judgment is appropriate when there is no genuine dispute as to any material fact and the moving party is entitled to judgment as a matter of law. *Id.* The party seeking summary judgment bears the initial burden of informing the court of the basis for its motion, and of identifying those portions of the pleadings and discovery responses that demonstrate the absence of a genuine issue of material fact. *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986). Material facts are those that might affect the outcome of the case. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). A dispute as to a material fact is

1 “genuine” if there is sufficient evidence for a reasonable jury to return a verdict for the nonmoving
2 party. *Id.*

3 Where the moving party will have the burden of proof at trial, it must affirmatively
4 demonstrate that no reasonable trier of fact could find other than for the moving party. *Soremekun*
5 *v. Thrifty Payless, Inc.*, 509 F.3d 978, 984 (9th Cir. 2007). On an issue where the nonmoving
6 party will bear the burden of proof at trial, the moving party may carry its initial burden of
7 production by submitting admissible “evidence negating an essential element of the nonmoving
8 party’s case,” or by showing, “after suitable discovery,” that the “nonmoving party does not have
9 enough evidence of an essential element of its claim or defense to carry its ultimate burden of
10 persuasion at trial.” *Nissan Fire & Marine Ins. Co., Ltd. v. Fritz Cos., Inc.*, 210 F.3d 1099, 1105-
11 06 (9th Cir. 2000); *see also Celotex*, 477 U.S. at 324-25 (noting a moving party can prevail merely
12 by pointing out to the district court that there is an absence of evidence to support the nonmoving
13 party’s case).

14 When the moving party has carried its burden, the nonmoving party must respond with
15 specific facts, supported by admissible evidence, showing a genuine issue for trial. Fed. R. Civ. P.
16 56(c), (e). The asserted disputed facts must be material – the existence of only “some alleged
17 factual dispute between the parties will not defeat an otherwise properly supported motion for
18 summary judgment.” *Anderson*, 477 U.S. at 247-48. “[M]ere allegation and speculation do not
19 create a factual dispute for purposes of summary judgment.” *Nelson v. Pima Cmty. Coll.*, 83 F.3d
20 1075, 1081-82 (9th Cir. 1996) (affirming summary judgment in favor of defendants where there
21 was “no evidence in the record from which a trier of fact could have” found for plaintiff).

22 When deciding a summary judgment motion, courts must view the evidence in the light
23 most favorable to the nonmoving party and draw all justifiable inferences in their favor. *Id.* at
24 255; *Hunt v. City of Los Angeles*, 638 F.3d 703, 709 (9th Cir. 2011). However, when a non-
25 moving party fails to produce evidence rebutting the moving party’s showing, then an order for
26 summary adjudication is proper. *Nissan Fire*, 210 F.3d at 1103 (“If the nonmoving party fails to
27 produce enough evidence to create a genuine issue of material fact, the moving party wins the
28 motion for summary judgment.”). The court’s function on a summary judgment motion is not to

1 make credibility determinations or weigh conflicting evidence with respect to a disputed material
2 fact. *See T.W. Elec. Serv., Inc. v. Pac. Elec. Contractors Ass’n*, 809 F.2d 626, 630 (9th Cir. 1987).

3 **B. Deckers’s Motion for Summary Judgment**

4 Deckers moves for summary judgment on its federal and state trade dress infringement
5 claims. To succeed on a claim for infringement of an unregistered trade dress, “a plaintiff must
6 demonstrate that (1) the trade dress is nonfunctional, (2) the trade dress has acquired secondary
7 meaning, and (3) there is a substantial likelihood of confusion between the plaintiff’s and
8 defendant’s products.” *Art Attacks Ink, LLC v. MGA Ent. Inc.*, 581 F.3d 1138, 1145 (9th Cir.
9 2009); *see also Wal-Mart Stores v. Samara Bros.*, 529 U.S. 205, 216 (2000). “As a general
10 matter, trademark claims under California law are ‘substantially congruent’ with federal claims
11 and thus lend themselves to the same analysis.” *Grupo Gigante S.A. de C.V. v. Dallo & Co.*, 391
12 F.3d 1088, 1100 (9th Cir. 2004). The Court begins with nonfunctionality, and finding that
13 Deckers has not met its burden on this factor, concludes it is appropriate to deny its motion for
14 summary judgment on these claims.

15 “[F]or a product’s design to be protected under trademark law, the design must be
16 nonfunctional.” *Blumenthal Distrib., Inc. v. Herman Miller, Inc.*, 963 F.3d 859, 864 (9th Cir.
17 2020). Two types of functionality exist – utilitarian and aesthetic – and if the claimed trade dress
18 has either type, it is unprotectable by trademark law. *Id.* at 865. “A claimed trade dress has
19 utilitarian functionality if it is essential to the use or purpose of a product or affects its cost or
20 quality.” *Id.* “[F]unctionality is generally viewed as an intensely factual issue,” *Tie Tech, Inc. v.*
21 *Kinedyne Corp.*, 296 F.3d 778, 783 (9th Cir. 2002) (citation omitted), and is often left to the jury,
22 although “the Ninth Circuit has determined the issue of functionality as a matter of law where the
23 plaintiff sought to protect the shape of a purely utilitarian product,” *Sw. MFG. LLC v. Wilmar*
24 *LLC*, No. CV 22-8541-MWF (PDX), 2024 WL 3718371, at *10 (C.D. Cal. July 16, 2024)
25 (collecting cases). Courts assessing whether utilitarian functionality is present consider “(1)
26 whether the design yields a utilitarian advantage, (2) whether alternative designs are available, (3)
27 whether advertising touts the utilitarian advantages of the design, and (4) whether the particular
28 design results from a comparatively simple or inexpensive method of manufacture.” *Blumenthal*,

1 963 F.3d at 964 (citing *Disc Golf Ass’n v. Champion Discs, Inc.*, 158 F.3d 1002, 1006 (9th Cir.
2 1998)).

3 Deckers asserts its Trade Dresses are nonfunctional. Dkt. No. 124 at 20-22. It contends
4 none of the trade dresses provide a utilitarian advantage over another boot or clog design in the
5 market, that many designs exist as alternatives, and that it does not advertise that the overall
6 appearance of any of the three products provide any sort of functional advantage. *Id.* at 21-22.
7 Deckers argues the design of the products do not result from an inexpensive method of
8 manufacturing. *Id.* at 22. Finally, it contends that the patents it obtained on its Mini and Bailey
9 Button products are presumptive evidence of nonfunctionality. *Id.* at 21 (citing *Govino LLC v.*
10 *White Poles LLC*, 2017 WL 6442187, at *9 (N.D. Cal. Nov. 3, 2017)). Because Deckers will bear
11 the burden of proof at trial on its infringement claims, it carries the burden of establishing that “no
12 reasonable trier of fact could find other than for” it. *Soremekun*, 509 F.3d at 984.

13 Quince has responded with specific facts showing a genuine issue of trial on the issue of
14 utilitarian functionality. Quince cites the opinion of its expert, Dennis Comeau, concluding that
15 the Asserted Products contain features that “affect[] [their] cost or quality” and therefore are
16 functional. Dkt. No. 166 at 22-23. Quince also contests Deckers’s argument that it does not
17 advertise that the overall appearance of its products provide any sort of functional advantage
18 because there is evidence that Deckers advertises the Mini has having “built-in flair with a lower
19 shaft which makes for easy on-off wear” and “a flexible, ultralightweight sole,” and that Deckers
20 “design[s] products to last.” *Id.* Although the parties dispute the weight to be given to their
21 respective experts, Quince’s arguments put forward specific facts that preclude summary judgment
22 on this issue.

23 Moreover, Deckers does not address aesthetic functionality. “A claimed trade dress has
24 aesthetic functionality if it serves an aesthetic purpose wholly independent of any source
25 identifying function, such that the trade dress’s protection under trademark law would impose a
26 significant non-reputation-related competitive disadvantage on its owner’s competitors.”
27 *Blumenthal*, 963 F.3d at 964. Because a trade dress with either utilitarian or aesthetic
28 functionality cannot be protected by trademark law, Deckers’s motion fails for the independent

reason that it has not carried its burden of showing aesthetic nonfunctionality. The Court thus **DENIES** its motion for summary judgment on its trade dress infringement claims.

The parties agree that the standard for trade dress infringement is the same under both state and federal law. Dkt. No. 124 at 33 (“As the standard for trade dress infringement is the same under both state and federal law . . . Deckers should also prevail on its state law claims for trade dress infringement and unfair competition”); Dkt. No. 161 at 31 (“Deckers admits that its state law claims are subject to the same standards governing its federal trade dress claims; they should fail for the same reasons.”). Because the Court denies Deckers’s motion as to its federal trade dress infringement claims, it **DENIES** its motion as to the state law claims, as well. *Grupo Gigante*, 391 F.3d at 1100.

Accordingly, Deckers’s motion for summary judgment is **DENIED**.

C. Quince’s Motion for Partial Summary Judgment

The Court now turns to Quince’s motion for partial summary judgment. Quince moves for summary on the following grounds: (1) that the federal and state law claims for trade dress infringement of the Mini and Tasman Trade Dresses fail because those Trade Dresses are generic; (2) that the unfair competition claim based on the Mini and Tasman fails because there is no protectable trade dress; (3) that Deckers’s patent infringement claim fails because the asserted patent is invalid; and (4) that Deckers’s “lost profits” damages theory fails for lack of causation and, as to its patent claim, must be barred for failure to disclose. Dkt. No. 142. Each argument is addressed in turn below.

1. Trade Dress Infringement

Quince moves for summary judgment on Deckers’s claims for the Lanham Act trade dress infringement of the Mini (Count 1) and the Tasman (Count 3). Quince argues the Mini and Tasman Trade Dresses are generic, and therefore not entitled to protection, because (1) they are overbroad or too generalized; (2) they are the basic form of a type of product; and (3) they are so common in the industry they cannot identify a particular source. Dkt. No. 142 at 26 (citing *Walker & Zanger, Inc. v. Paragon Indus., Inc.*, 549 F. Supp. 2d 1168, 1174 (N.D. Cal. 2007)). Quince does not argue the Bailey Trade Dress is generic.

The Lanham Act does not protect generic trade dresses. *Kendall-Jackson Winery, Ltd. v. E. & J. Gallo Winery*, 150 F.3d 1042, 1048 (9th Cir. 1998) (affirming summary judgment that grape leaves are generic emblem for wine and not entitled to trademark or trade dress protection). “[T]he plaintiff has the burden of proving nongenericness once the defendant asserts genericness as a defense.” *Filipino Yellow Pages, Inc. v. Asian J. Publications, Inc.*, 198 F.3d 1143, 1146 (9th Cir. 1999) (collecting cases). “In the Ninth Circuit, courts considering trade dress look to the overall visual impression or total combination of elements as opposed to viewing each element in isolation. This approach applies not only to functionality, but also to the issue of genericness.” *Adidas Am., Inc. v. Skechers USA, Inc.*, No. 3:15-CV-01741-HZ, 2017 WL 3319190, at *6 (D. Or. Aug. 3, 2017) (citing *Clicks Billiards v. Sixshooters, Inc.*, 251 F.3d 1252, 1259 (9th Cir. 2001)). “Cases addressing product design suggest that the term ‘genericness’ covers three situations: (1) if the definition of a product design is overbroad or too generalized; (2) if a product design is the basic form of a type of product; or (3) if the product design is so common in the industry that it cannot be said to identify a particular source.” *Walker*, 549 F.Supp.2d at 1174.

Here, Quince argues both the Mini Trade Dress and the Tasman Trade Dress are “so common in the industry that [they] cannot be said to identify a particular source.” Dkt. No. 161 at 17. As to the Mini, Quince argues there are at least 14 competitors in the market that sell a similar ankle-high sheepskin boot, and thus, under *Walker*, the Mini Trade Dress is generic. Similarly, Quince argues there are at least 9 competitors that sell moccasin and clog slippers similar to the Tasman. Quince points to the Comeau expert report, which includes screenshots depicting products with similar appearances to Deckers’s products and concludes they are competitors.

Deckers’s arguments in opposition do not hold water. First, Deckers objects to the admission of the screenshots on which Quince’s experts rely in determining the number of competitors in the market selling a similar product. The Court found this evidence admissible, and overruled Deckers’s objection at the September 4, 2025 hearing. Deckers also argues that the Trade Dresses are not generic because not “a single product closely resembling the UGG Classic Ultra Mini or the Tasman was being sold in commerce prior to the[ir] introduction.” Dkt. No. 164 at 8. But Deckers has pointed to no authority, neither in its papers nor at the hearing, requiring

that the competitor product must have been sold prior to its products. Similarly, Deckers offered no authority requiring Quince to provide information as to “where [the goods] were sold, in what quantity, and . . . whether they are knockoffs of” Deckers’s products. Deckers does not otherwise contest that the similar footwear Quince identifies as competitors are, in fact, competitors that can be assessed for purposes of determining genericness. Deckers has not carried its burden of proving nongenericness. *See Filipino Yellow Pages, Inc.*, 198 F.3d at 1146. Consequently, the Court concludes Quince is entitled to summary judgment on its genericness defenses against the trade dress infringement claims.

Because the Court finds summary judgment appropriate on the Lanham Act claims as to the Mini and Tasman, so too is it appropriate on the state trade dress infringement and unfair competition claims. *Academy of Motion Picture Arts & Scis. v. Creative House Promotions, Inc.*, 944 F.2d 1146, 1457 (9th Cir. 1991) (“An action for unfair competition under Cal. Bus. & Prof. Code §§ 17200 *et seq.* is ‘substantially congruent’ to a trademark infringement claim under the Lanham Act”); *see also Salt Optics, Inc. v. Jand, Inc.* No. SACV 10-0828 DOC, 2010 WL 4961702, at *8 (C.D. Cal. Nov. 19, 2010) (finding an unfair competition claim that arose “solely from [defendant’s] allegedly unauthorized appropriation of [plaintiff’s] trade dress . . . must be dismissed for the same reasons [plaintiff’s] trade dress claim must be dismissed”).

2. Patent Infringement

Finally, Quince argues Deckers’s patent infringement claim fails because the ’161 Patent is invalid and argues Deckers may not recover lost profits damages for its patent invalidity claim. The Court addresses each in turn below. Dkt. 147-2 at 20.

a. Patent Invalidity

Under 35 U.S.C. § 282, patents are entitled to a presumption of validity, which can be overcome only by clear and convincing evidence. *See, e.g., Microsoft Corp. v. i4i Ltd. P’ship*, 564 U.S. 91, 95 (2011). Patent invalidity is an affirmative defense that the alleged infringer has the burden of proving by clear and convincing evidence. *Hong Kong uCloudlink Network Tech. Ltd. v. SIMO Holdings Inc.*, 548 F. Supp. 3d 916, 921 (N.D. Cal. 2021) (quoting *Impax Labs., Inc. v. Aventis Pharm., Inc.*, 468 F.3d 1366, 1378 (Fed. Cir. 2006)).

Quince argues the '161 Patent is invalid as (1) functional and (2) indefinite and non-enabling. Dkt. No. 142 at 31. "A design patent is invalid if the patented design is 'primarily functional,' rather than primarily ornamental, or if function dictates the design." *Eldon Indus., Inc. v. Vanier Mfg., Inc.*, 923 F.2d 869 (Fed. Cir. 1990) (citation omitted). Quince challenges the following aspects of the claimed design as "dictated by function" and argues they should be excluded from the scope of the claim: (1) the horizontal butt seam; (2) the vertical butt seams; (3) the thermoplastic imprints at the heel counter; (4) the pull tab; (5) the sloped top opening of the boot; and (6) the binding around the boot collar. *Id.* at 32. Citing to its footwear expert's opinion that "functional concerns dictated the claimed design," Quince urges the Court to find that the '161 Patent is primarily functional. However, "the utility of each of the various elements that compromise the design is not the relevant inquiry. . . . The elements of the design may indeed serve a purpose, but it is the ornamental aspect that is the basis of the design patent," *L.A. Gear*, 988 F.2d at 1123, and Quince's brief treatment of functionality does not satisfy its burden of proving invalidity by clear and convincing evidence. *Hong Kong uCloudlink Network Tech.*, 548 F. Supp. 3d at 921.

Quince also argues the patent is invalid for indefiniteness. Dkt. No. 142 at 32. "[A] patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention." *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898 (2014). The figures depict two types of solid lines, which both parties' experts agree could represent either "pleats/seams or contours," and Quince argues the depictions are indefinite because the inconsistent use of the lines would make it "impossible for a designer of ordinary skill in the art, viewing the figures from the perspective of an ordinary observer, to understand whether these lines represent pleats/seams or contours or which lines represent pleats/seams and which represent contours." *See* Dkt. No. 142 at 33. Further, Quince argues that there are "multiple, internally inconsistent drawings" that would prevent a "designer of ordinary skill" from understanding what is claimed or how to make the design. *Id.* at 34. A court in this Circuit rejected a similar argument from a defendant about another (now expired) one of Deckers's patents. There, the

defendant challenged the patent as indefinite because some of the drawings depict the boot with a V-shaped notch on the top inward-facing side of the boot, whereas others do not. *Deckers Outdoor Corp. v. Romeo & Juliette, Inc.*, No. 215CV02812ODWCWX, 2016 WL 7017219, at *4 (C.D. Cal. Dec. 1, 2016). The court found “a reasonable boot designer, in deciding whether the claimed design includes a notch, would look to the drawings that provide the clearer – not the more obscured – view of that part of the boot.” *Id.* That reasoning applies here, and is persuasive. The Court thus does not find it “clearly convinc[ing] that these discrepancies are of such magnitude that a boot designer and manufacturer could not determine with reasonable certainty the overall appearance of the boot.” *Id.*

Quince argues that even if the Court finds the claimed design is not primarily functional, it still has a duty to conduct claim construction in design patent cases. Deckers strongly opposes Quince’s suggestion to “essentially reset the scheduling order with a formal claim construction,” and contends a “verbal claim construction is unnecessary and should be avoided.” Dkt. No. 164 at 30, 31 n.27. “Where a design contains both functional and nonfunctional elements, the scope of the claim must be construed in order to identify the non-functional aspects of the design as shown in the patent. . . . In doing so, however, the Court cannot ‘entirely eliminate a structural element from the claimed ornamental design,’ for ‘design patents protect the overall ornamentation of a design, not an aggregation of separable elements.’ ” *Romeo & Juliette*, 2016 WL 7017219, at *5 (citing *Sport Dimension, Inc. v. Coleman Co.*, 820 F.3d 1316, 1321 (Fed. Cir. 2016)).

Further, designs are “better represented by an illustration” and courts should be mindful of the risks in providing a written construction of a design patent, “such as the risk of placing undue emphasis on particular features of the design and the risk that a finder of fact will focus on each individual described feature in the verbal description rather than on the design as a whole.” *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 680 (Fed. Cir. 2008) (en banc). Accordingly, courts are “not obligated to issue a detailed verbal description of the design if it does not regard verbal elaboration as necessary or helpful.” *Id.* Indeed, courts have found Deckers’s boot patents do not require claim construction. *See Deckers Outdoor Corp. v. Rue Servs. Corp.*, No. CV1306303JVSVBKX, 2014 WL 12588481, at *2 (C.D. Cal. Aug. 29, 2014) (“Upon review, the

1 Court determines that a detailed verbal description of the claimed designs is unnecessary in this
2 case.”). In sum, Quince has not shown why claim construction is required here. Its motion for
3 summary judgment on the patent infringement claim is thus **DENIED**.

4 **b. Lost Profits Damages**

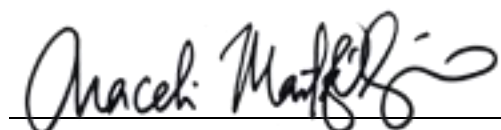
5 Quince argues Deckers’s lost profits theory of damages for its patent infringement claim is
6 improper because Deckers did not disclose it, as the first time lost profits was identified as a form
7 of damages Deckers intended to seek was in Deckers’s opening expert report. Deckers does not
8 contest this argument. *See Namisnak v. Uber Techs., Inc.*, 444 F. Supp.3d 1136, 1146 (N.D. Cal.
9 2020) (quoting *Ardente, Inc. v. Shanley*, No. C 07-4479 MHP, 2010 WL 546485, at *6 (N.D. Cal.
10 Feb. 9, 2010)) (“Plaintiff fails to respond to this argument and therefore concedes it through
11 silence.”). The Court therefore **GRANTS** Quince’s motion for summary judgment and precludes
12 Deckers from bringing a lost profits theory of damages for its patent infringement claim.

13
14 **III. CONCLUSION**

15 For the foregoing reasons, the Court **DENIES** Deckers’s motion for summary judgment,
16 **GRANTS** Quince’s motion for partial summary judgment as to the trade dress infringement
17 claims and lost profits theory of damages and **DENIES** its motion for summary judgment as to the
18 patent infringement claim.

19
20 **IT IS SO ORDERED.**

21 Dated: October 2, 2025

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23 
24 **ARACELI MARTÍNEZ-OLGUÍN**
25 **United States District Judge**
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